

REMARKS

The Office Action dated April 5, 2004, has been received and carefully considered. In this response, claims 17 and 18 have been added, and claims 1, 3, 7, 11, and 16 have been amended. Entry of added claims 17 and 18, and the amendments to claims 1, 3, 7, 11, and 16 is respectfully requested. Reconsideration of the outstanding rejections in the present application is also respectfully requested based on the following remarks.

At the outset, Applicant notes with appreciation the indication on page 4 of the Office Action that claims 7-10 are allowed. Applicant also notes with equal appreciation the indication on page 4 of the Office Action that claims 2-6, 12, 14, and 15 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, Applicant has opted to defer rewriting the above-identified claims in independent form pending reconsideration of the arguments presented below with respect to the rejected claims.

I. THE INDEFINITENESS REJECTION OF CLAIMS 1 AND 11

On page 2 of the Office Action, claims 1 and 11 were rejected under 35 U.S.C. § 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the invention. This rejection is hereby respectfully traversed with amendment.

The Examiner asserts that the term "in the presence of an identified IP telephone" is unclear.

It is respectfully submitted that claims 1 and 11 have been amended to address the concerns of the Examiner.

In view of the foregoing, it is respectfully requested that the aforementioned indefiniteness rejection of claims 1 and 11 be withdrawn.

II. THE OBVIOUSNESS REJECTION OF CLAIMS 1, 11, 13, and 16

On pages 2-4 of the Office Action, claims 1, 11, 13, and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bateman et al. (U.S. Patent No. 6,311,231) in view of Jones et al. (U.S. Patent No. 6,141,341). This rejection is hereby respectfully traversed.

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Also, as stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Further, as stated in MPEP § 2143.01, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d

1382, 165 USPQ 494, 496 (CCPA 1970). Additionally, as stated in MPEP § 2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Finally, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Examiner asserts that Bateman et al. substantially teaches all the limitations of claims 1, 11, and 16. More specifically, the Examiner asserts that Bateman et al. teaches a system and a method for providing directory assistance (DA) in response to a DA operator (agent workstation 12 in Fig. 1 and column 5, lines 21-31) received from a calling party telephone (customer premise 2 in Fig. 1 and column 5, lines 1-10) having a directory number (DN) identifying the calling party phone (corresponding customer records in a database, column 9, lines 10-18 or column 10, lines 39-50), phone accessing the telephone system through PSTN (phone line 10 in Fig. 1 and column 5, lines 1-10) and through internet (Internet line 6 in Fig. 1 and column 5, lines 1-10), comprising: a DA signal processor with memory for storing the DN telephones (call center's customer info

system 42 in Fig. 1 and column 5, lines 46-50), each DN being stored in the memory in relationship with additional party information (800 numbers on column 1, lines 22-37); a telephone switch (digital switch 34 with CTI software in Fig. 1), responsive to receipt of a DA number and having a processor and memory for determining the type of calling phone (CTI using CLID, column 9, lines 1 - 18); reporting the requested DA information in voice format to the calling phone (column 10, lines 39-50) and forwarding the requested DA information in data file format to the calling party phone (column 10, lines 50-67). The Examiner acknowledges that Bateman et al. does not teach determining the type of the calling phone including IP telephone. However, the Examiner asserts that Jones et al. teaches determining the type of the calling phone including IP telephone (notifying the user if incoming call is a PSTN-based call or VoIP-based call, column 6, lines 17-27). The Examiner then goes on to assert that it would have been obvious to one of ordinary skill in the art at the time the invention was made to add determining the type of the calling phone including IP telephone of Jones et al. to the system of Bateman et al. to improve the system compatibility with IP telephones.

However, it is respectfully submitted that Bateman et al. does not in fact teach a calling party telephone having a DN

identifying the type of calling party telephone, including IP telephones capable of accessing the telephone system through the PSTN and through the internet. Specifically, the Examiner references column 9, lines 10-18 or column 10, lines 39-50, of Bateman et al. for a teaching that a calling party telephone has a DN identifying the type of calling party telephone. However, these references in Bateman et al. only discuss a caller providing a standard CLID (Calling Line Identification) to an agent for purposes of providing customer data to the agent. Nowhere does Bateman et al. disclose that the customer data is for identifying a type of telephone the caller is using. Indeed, Bateman et al. does not even contemplate IP telephones capable of accessing the telephone system through the PSTN and through the internet. Instead, Bateman et al. only discloses that a caller uses a standard telephone for voice communications and a separate computer for visual display of information. This is clearly different from an IP telephone capable of accessing the telephone system through the PSTN and through the internet, as claimed.

It is also respectfully submitted that Bateman et al. does not in fact teach processing means for determining the type of calling party telephone. Specifically, the Examiner references column 9, lines 1-18, of Bateman et al. for teaching processing

means for determining the type of calling party telephone. However, this reference in Bateman et al. only discusses a caller providing a standard CLID (Calling Line Identification) to an agent for purposes of providing customer data to the agent. Nowhere does Bateman et al. disclose that the customer data is for determining a type of telephone the caller is using. Indeed, Bateman et al. does not even contemplate anything other than standard telephones, and particularly not IP telephones capable of accessing the telephone system through the PSTN and through the internet. Instead, Bateman et al. only discloses that a caller uses a standard telephone for voice communications and a separate computer for visual display of information. This clearly does not support a teaching of providing processing means for determining the type of calling party telephone, as claimed.

It is further respectfully submitted that Bateman et al. does not in fact teach forwarding the requested DA information in data file format to the calling party telephone in the presence of an identified IP telephone, as claimed. Specifically, the Examiner references column 10, lines 50-67, of Bateman et al. for a teaching of forwarding the requested DA information in data file format to the calling party telephone. However, this reference in Bateman et al. discusses providing

information for viewing on a calling party's computer, which is totally separate from the calling party's telephone. Nowhere does Bateman et al. disclose forwarding the requested DA information in data file format to the calling party telephone. Indeed, Bateman et al. teaches away from this claimed feature since Bateman et al. teaches that a caller uses a standard telephone for voice communications and a separate computer for visual display of information. This is clearly in contrast to forwarding the requested DA information in data file format to the calling party telephone, as claimed.

It is additionally respectfully submitted that there would be no motivation to combine Bateman et al. with Jones et al. since there is no reason disclosed in Bateman et al. to identify a type of calling party telephone, nor does Bateman et al. suggest any benefit to identifying a type of calling party telephone. Indeed, as discussed above, Bateman et al. teaches away from this claimed feature since Bateman et al. teaches that a caller uses a standard telephone for voice communications and a separate computer for visual display of information. This is clearly in contrast to an IP telephone for receiving information in both voice and data formats, as claimed. Thus, it is respectfully submitted that the combination of Bateman et al. and Jones et al. has occurred only through the benefit of

hindsight in view of the specification and claims of the present application.

In view of the foregoing, it is respectfully submitted that claims 1, 11, and 16 should be allowable over Bateman et al. and Jones et al..

Claim 13 is dependent upon independent claim 11. Thus, since independent claim 11 should be allowable as discussed above, claim 13 should also be allowable at least by virtue of its dependency on independent claim 11.

At this point it should be noted that claims 1, 3, 7, 11, and 16 have been amended to more clearly recite the claimed features contained therein. Claims 17 and 18 have been added to recite additional features dependent upon claim 16.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 1, 11, 13, and 16 be withdrawn.

III. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to

expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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